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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/660,470      | 09/12/2003  | Tor Rafael Lund      | 134/125             | 4956             |

7590 05/04/2005  
Averill & Varn  
8244 Painter Ave.  
Whittier, CA 90602

EXAMINER

WILLATT, STEPHANIE L

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3732

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/660,470             | LUND ET AL.         |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Stephanie L. Willatt   | 3732                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 November 2004.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11, 13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-11, 13 and 14 is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Objections*

1. Claims 3-6 are objected to because of the following informalities: in line 2 of claim 3, "a holder" should be changed to --the holder-- in order to avoid a double inclusion. Appropriate correction is required.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rende in view of Allen, Jr.

Rende discloses a nail clipping assembly including a pair of clippers for clipping a fingernail or toenail. The nail clippers have an upper arm and a lower arm (elongate member 12,14). Each arm has a blade end (16,18) and a joined end and the upper and lower arms (elongate member 12,14) are joined at their joined ends. The upper arm (elongate member 12) has an upper blade at its blade end (16) and the lower arm (elongate member 1) has a lower blade at its blade end (18). The upper and lower blades (16,18) are aligned to meet to form a cutting line. An operating lever (26) is held

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to the pair of nail clippers so that the depression of the operating lever causes the upper blade (16) to move downwardly and meet the lower blade (18) to create a cutting action.

A light source (46) is held near the upper and lower blades (16,18) and is positioned below said lower blade (Figure 4), said light source emitting a beam of light so that when a finger is moved so that an extending nail portion at a distal end of the finger moves between the upper blade (16) and the lower blade (18), the light source (46) will illuminate at least that portion of the interior of the finger under its nail so that an intersection between the extending portion of the nail and the finger is clearly visible. The beam of light emitted from the light source (46) illuminates the "region beyond said first end of said elongate members [12,14]", as stated in lines 37-42 of column 6, from below. Therefore, the light source (46) illuminates the intersection between the nail and the finger. A means for energizing the light source (46) includes a battery (48) and a switch, as described in column 5, lines 4-8.

A holder (housing 29, misprinted in specification as 26) has a recess along the top for holding the pair of nail clippers so that the upper (16) and lower blades (18) thereof may be moved adjacent the end of a subject's finger end and over a subject's extending nail. The holder (housing 29) has a hand graspable handle and a cutting end. The holder (housing 29) further supports the light source at its cutting end, as shown in Figure 4. The holder (housing 29) has a receptacle (small housing 50) for holding the means for energizing the light source (battery 48 and switch). The light source (46) is a pen light, as discussed in column 5, lines 4-8. It is well known that pen

lights have incandescent bulbs. The finger tip portion of the subject's finger could moved to any distance from the tip of the light bulb, even when the light source is located in the receptacle, since it is not fixed to the apparatus.

Rende does not disclose the distance between the bulb and the finger tip of a user when the subject's finger is located so that the fingernail is between the upper and lower blades. However, claim 6 of Rende states that the light is mounted for "illuminating a region beyond said first end of said elongate members." It would have been obvious to one having ordinary skill in the art at the time the invention was made to position the bulb within the holder so that its tip is within at least about one-eighth of an inch from a finger tip portion of the subject's finger when the subject's finger is located so that the fingernail is between the upper and lower blades, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233 (CCPA 1955).

Rende does not disclose that the holder extends past the joined end of the nail clippers, as recited in lines 16-18 of claim 1. However, Allen, Jr. discloses a housing (clipping receptacle 10) that extends past the joined end of a pair of nail clippers (50) so that the end of the clippers are enclosed, as shown in Figure 5. This configuration prevents nail clippings from escaping from the end of the housing (clipping receptacle 10). In Rende, the holder (housing 29) includes a foam seal (52) that seals against the bottom of the nail clippers to prevent nail clippings from escaping from the end of the housing (29), as explained in column 5, lines 15-17. It would have been obvious to one

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having ordinary skill in the art at the time the invention was made to extend the housing of Rende past the joined end of the nail clippers so that it encloses the joined end of the nail clippers, as taught by Allen, Jr., since an enclosed end would be an art recognized functional equivalent of the foam seal of Rende.

***Allowable Subject Matter***

4. Claims 8-11, 13, and 14 are allowed.

***Response to Arguments***

5. Applicant's arguments filed 20 April 2005 have been fully considered but they are not persuasive. Applicant argues that Rende does not suggest that the light is to be used to illuminate a finger during a cutting operation. However, claim 6 of Rende states that the light illuminates a region beyond the first end of the elongate members (12, 14), which is where the fingertip is positioned when a fingernail is being cut. In darkness, the light would illuminate the intersection between the extending portion of the nail and the finger so that the intersection is clearly visible.

Applicant argues that putting the light bulb 1/8" from the fingertip when the fingernail is being trimmed produces new and unexpected results. However, it is not new and unexpected to put a light source close to the region you wish to illuminate. Rende states that the light is mounted for "illuminating a region beyond said first end of said elongate members." It would have been obvious to put the light source near "a

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region beyond the first end of said elongate members" since this is the region to be illuminated.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephanie L. Willatt whose telephone number is (571) 272-4721. The examiner can normally be reached on M-F (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
slw

  
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